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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS LUCA CONTE

Appeal 2008-003533
Application 10/643,288
Technology Center 3600

Before: WILLIAM F. PATE III, JENNIFER D. BAHR, and
JOHN C. KERINS, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

This is a decision on a Request for Rehearing filed on April 28, 2009. The Board issued a Decision on March 2, 2009.

We deny.

ANALYSIS

This is a response to a request for rehearing in the above noted appeal. Requests for rehearing are limited to matters overlooked or misapprehended by the Panel in making the original Decision. In the introduction to Appellant's Request for Rehearing Appellant states that the Board has made erroneous findings of fact, failed to properly apply the *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) decision, not considered Appellant's claims as a whole, and has used impermissible hindsight in the obviousness rejections of Appellant's claims on appeal. Appellant further states that the Board has distorted facts, misapplied the four references out of context, misapplied *KSR*, and failed to consider the claims as a whole.

Several of Appellant's arguments recur throughout the Request for Rehearing and we consider these recurring arguments first.

Appellant discusses our footnote 3 which pertains to the Examiner rejecting claims as obvious over White in view of Watkins and rejecting claims as obvious over Watkins in view of White. Ans. 3. The following is a quote from *In re Bush*, 296 F.2d 491, 496 (CCPA 1961) which is the case that we cited in our footnote:

In a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of on B in

view of A, or to term one reference primary and the other secondary. It would perhaps have saved much argument of the kind we have before us if the Patent Office had stayed with its rejection of the claims as unpatentable over A and B ‘considered together’ and had merely stated its reasons for such rejection without formal alinement of the references. Fifteen years ago this court pointed out in *In re Cowles*, 156 F.2d 551, 554[CCPA 1946], that such differing forms of expression did not constitute different grounds of rejection, were of little consequence, and that basing arguments on them was ‘attempting to make a mountain out of a mole-hill.’

As is apparent from this jurisprudence, rejections under 35 U.S.C. § 103 are based on the combined teachings of the references. Therefore, with rejections made on obviousness grounds under 35 U.S.C. § 103, a rejection labeled A in view of B is really the same as a rejection labeled B in view of A. This was the principle of law we were trying to convey in our footnote 3, albeit in a brief, perhaps too concise, way.

We also note that Appellant argues at numerous places about how this or that feature from one reference could not be incorporated in another reference. However,

[T]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.

In re Keller, 642 F.2d 414, 425 (CCPA 1981) (citations omitted); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (citations omitted) (“it is not necessary that the invention of the references be physically combinable to render obvious the invention under review”); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“[c]ombining the *teachings* of references does not involve an ability to combine their specific structures”). Thus, a conclusion of obviousness does not require, for example, the features of Watkins to be

bodily incorporated into the gun of White. Arguments based on such a bodily incorporation therefore fail to convince us that we have overlooked or misapprehended matters in our original Decision.

We further note that Appellant quoted *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951) at several points in the Request for Rehearing. Appellant's argument is that his preamble states that the claimed subject matter is directed to an insect swatter, while the applied references are directed to toy rubber band guns. A preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use of the invention." *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997).

Perhaps a simple example would serve to illustrate this principle for Appellant. Consider the following claim: "A heavy doorstop comprising a rectangular parallelepiped block of fired clay." We all recognize the subject matter of the claim is a brick. Can the inventor obtain patent protection by reciting that the invention is a doorstop? No, in this case the preamble is not limiting. Likewise in Appellant's claims on appeal, the body of the claims define structurally complete inventions, and the preambles only state a purpose or intended use of the invention.

Additionally, the Kopp patent has relevance to this matter. While Kopp titles his invention a toy gun, the invention is disclosed as for striking flies or other insects. See Kopp, p. 1, ll. 14-15. Therefore, Kopp demonstrates a recognition in the art that toy guns that shoot or whip rubber bands can be used to kill flies. This is an express disclosure that the cited references function as fly swatters.

At several locations in the Request for Rehearing Appellant argued dismissively about the status of the applied references as “mere toys.” We do not believe that our Decision implied that toys are not a serious field for inventive endeavor or somehow have a secondary status in the useful arts. Many simple toys have been patented and have brought pleasure to millions. We are not convinced that the references applied by the Board and the Examiner have a secondary status in the art because they are directed to toys. This is especially true, inasmuch as at least one of these toy patents recognizes that these toys have a practical utility in that they can strike flies or other insects.

Along this line, Appellant argued that the applied references having the nature of toys are not analogous art to Appellant’s insect swatter. Even if we were to ignore the express teaching in Kopp that rubber band guns can be used to shoot or whip flies and other insects, we believe that these toys, notwithstanding their toy label, are reasonably pertinent to Appellant’s problem, and as we noted in our Decision, the Federal Circuit agreed with this assessment in a prior appeal. *See In re Conte*, 36 Fed. App’x. 446, 450 (Fed. Cir. 2002). As such, we believe that Appellant’s arguments with respect to non-analogous art are foreclosed by a prior court decision.

Throughout the Request for Rehearing, Appellant challenges our Finding of Fact 3. For example, on page 4 Appellant states that the Finding of Fact 3 “is clearly erroneous, . . . reliance thereon is . . . unwarranted and erroneous.” Our finding was merely that the rubber bands of White appear identical and there is little reason to suspect that they are not. Therefore, we found that, to a preponderance of the evidence, White discloses that identical rubber bands are used when multiple rubber bands are employed. Decision

Our understanding of White is that the rubber bands are transversely cut from the undamaged tube of an unusable tire inner tube. When the tube is cut transversely, multiple rubber bands are formed. Due to the cross-sectional nature of the cut and the uniformity of the inner tube, the bands all have the same circumference and the same thickness and they are composed of the same material. The only unknown dimensional characteristic of the bands is the thickness of the bands in the circumferential direction of the entire inner tube. In examining Figures 1 and 2 of White, this width appears to be similar for all three rubber bands depicted. Therefore, the only evidence we have about the bands in White points to the rubber bands being essentially similar, if not identical. Thus it was our finding that by a preponderance of the evidence the rubber bands of White are apparently identical. We acknowledged in our finding that White does not state that the rubber bands are identical, but on the other hand, he does not state that they are not identical. So we carefully weighed the evidence and determined that the rubber bands of White were substantially identical to a preponderance of the evidence.

Appellant states that the White rubber bands are hand cut. Req. Reh'g. 8. In our view this is speculation on the part of the Appellant. Appellant further states on page 6 of the Request for Rehearing that White's rubber bands are expressly not identical. This is not the case as we have found that White is silent with respect to whether the rubber bands are identical or not. Moreover, it was our finding in Finding of Fact 21 that standard rubber bands are commercially available at common stationery supply stores. Decision 9. We regard this as an admission by Appellant about the prior art, and if this admission were not present, we would have taken Official Notice that packaged, identical rubber bands are available.

On page 14 of our Decision we discussed the obviousness of using identical rubber bands and stated that the use of identical rubber bands available in packages is a matter of design choice which does no more than yield a predictable result of facilitating construction. We might add that using identical rubber bands also aids in the consistency of operation of the device.

In summary, we stand by Finding of Fact 3 and point out to Appellant that even if White did not teach the use of identical rubber bands, the use of such rubber bands would have been obvious to one of ordinary skill in the insect swatter art.

On page 6 of the Request for Rehearing, Appellant argues that our Finding of Fact 10 regarding the slot is irrelevant. Finding of Fact 10 is directed to the scope and content of the White reference and it also states the differences between White and the claimed subject matter. Decision 7. Appellant has failed to state any matter misapprehended or overlooked with respect to Finding of Fact 10.

On page 7 of the Request for Rehearing Appellant criticizes Finding of Fact 12. Finding of Fact 12 states that Watkins discloses that a rubber band gun may be converted between operational modes wherein upon firing the rubber band is ultimately retained on the gun or discharged from the gun. Decision 7. In our view, Finding of Fact 12 is fully justified from the disclosure of Watkins. One of ordinary skill would understand from the disclosure that whether the rubber band is retained on the gun is entirely optional and that a gun may be converted to operate either way.

Appellant criticizes Finding of Fact 13 on page 8 of the Request for Rehearing. Appellant partly bases his criticism on the fact that he has conjectured that the rubber bands of White are handmade. As noted above, this is a supposition or conjecture by Appellant. Furthermore we must

reiterate that use of identical rubber bands in an insect swatting device is a use of a simple expedient in the art having predictable results and thus is not a patentable step or element under *KSR*.

On page 8 of the Request for Rehearing, Appellant mentions his prior patent (Conte, US 6,851,218). As Appellant is aware, the claims in that patent are directed to latch features not claimed in the present application.

On page 9 of the Request for Rehearing, Appellant criticizes our application of Hooke's Law but does not allege that we misapprehended or overlooked any matters relevant to Hooke's Law in Finding of Fact 13.

Also on page 9 of the Request for Rehearing, Appellant criticizes our Finding of Fact 15, but other than claiming that our finding has no relevance, Appellant does not specifically point out any matter that was overlooked or misapprehended.

Also on page 9 of the Request for Rehearing, Appellant takes issue with Finding of Fact 21 which Appellant says is an erroneous use of Appellant's own Specification. As explained above, it is clear that the fact referred to in Finding of Fact 21 is an admission by Appellant that standard rubber bands are commercially available. As noted above, if Appellant does not believe that this is an admission on his part, the Board hereby takes Official Notice that packages of rubber bands of identical character are available in stationery stores and office supply warehouses.

On page 9 of the Request for Rehearing, Appellant criticizes Finding of Fact 22 on the grounds of non-analogous art. On page 10 of the Request for Rehearing, Finding of Fact 23 is also disputed on the same basis. We have responded to this allegation, *supra*.

On page 10 of the Request for Rehearing, Appellant argues that Finding of Fact 26 is erroneous and taken out of context. We have carefully

reviewed this finding in light of Appellant's argument and can find no matter that was overlooked or misapprehended.

On page 11 of the Request for Rehearing, Appellant states that we have chosen to disregard the issuance of the parent patent. As noted above, the claims in the parent patent are directed to a latch feature not present in the claims on appeal.

On pages 11 and 12 of the Request for Rehearing, Appellant again argues that White is a toy gun whereas Appellant's invention is an insect swatter. We have considered these arguments, *supra*.

On page 13 of the Request for Rehearing, Appellant attacks our assertion that the intended purpose of White is to provide a toy and that there is no evidence that White would cease to be operable if the rubber band were fixed to the distal end of the gun. Appellant states that we have not stated a legal basis for this conclusion. It is clear from our Decision that White would not cease to function for its intended purpose, inasmuch as Watkins teaches that the rubber band could be a fixed lash in a handheld pistol-like toy.

Next, on page 14 of the Request for Rehearing, Appellant continues to discuss the issue of a toy vis-à-vis an insect swatter. We have discussed these issues, *supra*.

On page 15 of the Request for Rehearing, Appellant argues that *KSR* has been misapplied in that no predictable result has been pointed out. We refer Appellant to the sentence bridging pages 13 and 14 of our Decision. We further determined that Watkins teaches such a modification.

On page 16 of the Request for Rehearing, Appellant asks rhetorically where is the evidence in White "that instead of keeping the free end free that the free end could or would with any predictability be fixed to prevent

discharge.” Appellant’s argument is merely that White is not an anticipatory reference. This argument is of no moment as this rejection is under 35 U.S.C. § 103.

On pages 16 and 17 of the Request for Rehearing, Appellant again discusses the order of the references in the statement of the rejection. This has been discussed *supra*.

On page 18 of the Request for Rehearing, Appellant admits that Watkins teaches that its toy gun could be modified into the toy gun of White to shoot or discharge rubber bands. However, Appellant disputes that it would have been obvious for the converse modification. We reject this contention. The statute presumes that the worker in the relevant art will have ordinary skill. Appellant is positing some sort of automaton or robot worker with selective memory. Appellant is positing a worker in the art, that when expressly taught that A can be converted to B, is stymied when the conversion required is from B to A. In our view, the modification from A to B clearly suggests to the artisan that the modification of B to A is entirely predictable.

On pages 19 through 21 of the Request for Rehearing, Appellant includes arguments relating to the identical rubber bands. We have discussed Finding of Fact 13 and our conclusion that using commercial, identical rubber bands would have been obvious, *supra*.

On pages 23 through 25 of the Request for Rehearing, Appellant continues the discussion with respect to Hooke’s Law and the relative strengths of the rubber bands. We stand by our Findings of Fact on this issue and can find no material that Appellant has specifically pointed to which was overlooked or misapprehended.

On page 28 of the Request for Rehearing, Appellant discusses the various slots found in the references. We find nothing in this discussion that points to matters overlooked or misapprehended by the panel in rendering the Decision.

On page 29 of the Request for Rehearing, Appellant states that we have failed to address the specific features of the claim and used hindsight reconstruction in our analysis. We disagree with Appellant's characterization of the rationale for our rejection.

Furthermore, on page 30 of the Request for Rehearing, Appellant states that we have not considered the invention as a whole. We disagree with this assertion and refer Appellant to the explicit rationale of the rejection in our Decision.

On page 31 of the Request for Rehearing, Appellant states that the Board disregarded fundamental differences between Appellant's invention and that of the prior art. In our Findings of Fact we carefully reported the differences between the claimed subject matter and the applied prior art. Decision 5-10. Appellant has pointed to no matters misapprehended or overlooked in our Findings of Fact.

On page 32 of the Request for Rehearing Appellant again discusses the slots of the various references and argues that they are different. We admitted as much in our Decision. However, the relevant inquiry is whether the differences would have been obvious to one of ordinary skill in the art.

Appellant argues on page 32 of the Request for Rehearing that the Board has failed to state what simple substitutions with predictable results that the Board is relying on with respect to White and Watkins. As noted above, our Decision is clear in this regard and we will not comment further.

On pages 33 through 35 of the Request for Rehearing, Appellant again raises the issue of an insect swatter vis-à-vis a toy gun. We have discussed this issue, *supra*.

Pages 36 through 38 of the Request for Rehearing include an individual attack on the Watkins reference. Then Appellant states that the Board should provide caselaw and the requisite legal analysis for its rejections. As noted above, such a general request fails to point out matters that were overlooked or misapprehended.

On page 38 of the Request for Rehearing, Appellant states that it would be impossible to substitute the three band elastic member of White for the disparate single band of Kopp. As we explained at the outset, bodily incorporation is not the standard for a rejection under 35 U.S.C. § 103. Although the statute does not require bodily incorporation, it is unclear to us why this substitution would be physically impossible. Appellant does not explain, and Appellant further disregards the ordinary skill of the worker in this art to suitably size the elastic members.

On page 41 of the Request for Rehearing, Appellant states that the Kopp gun so modified would be unrecognizable to its inventor. Recognizability to the inventor is not the standard for obviousness under 35 U.S.C. § 103. Nor do we believe, as Appellant states on page 41 of the Request for Rehearing, that Kopp would fail in its intended purpose if so modified.

On page 42 of the Request for Rehearing, Appellant includes a discussion of how the features of the applied references cannot be bodily incorporated. As noted above, this is not the standard for 35 U.S.C. § 103.

On page 43 of the Request for Rehearing, Appellant states that we have ignored express claim language by referring to design choice and

Hooke's Law in the sizing of the elastic members. Appellant has failed to point out matters that were misapprehended or overlooked with regard to the nature of the elastic members.

On page 44 of the Request for Rehearing, Appellant again attacks our statement that the order of the references in the statement of the rejection is immaterial. We have discussed this issue, *supra*.

Also on page 44 of the Request for Rehearing, Appellant states that it is not a mere simple substitution to replace the triple band of White for the disparate band in Kopp as the bands are different, the mounts are different and the functions are different. As noted above, the real standard is whether these differences would have been obvious to one of ordinary skill. Our Decision answers in the affirmative.

On pages 44 and 45 of the Request for Rehearing, Appellant argues that notwithstanding the Board's conclusion that the order of references in the statement of rejection is immaterial, we have restated the rejections when relying on Kopp. We note that a rejection under the combined disclosures of White and Watkins is different from a rejection relying on the combined features of Kopp and White.

On pages 46 and 47 of the Request for Rehearing, Appellant mentions the prior Conte patent and asks that the Board apply *res judicata* to claims that find their support in the patent already issued. As noted above, this patent is directed to a latch which is not a part of the claimed subject matter.

Appellant states on page 47 of the Request for Rehearing, that he traverses the rejection under 35 U.S.C. § 103 based on Kopp, White and Stone. However, Appellant has failed to show any matter that was misapprehended or overlooked by the Board in rendering this rejection. What follows is merely a restatement of the arguments regarding simple

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substitution, toy vis-à-vis insect swatter, design choice and predictable result, and the alleged errors of fact. We have discussed these issues *supra*.

On page 50 of the Request for Rehearing, Appellant again raises the issue of *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). We have discussed this issue *supra*.

In summary, we have granted Appellant's Request for Rehearing to the extent that we have reconsidered our previous Decision. However, with respect to making any changes thereto, the Request for Rehearing is denied in its entirety. This is a final Agency decision for civil action or appeal.

DENIED

nlk

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